

REMARKS

In response to the Final Office Action dated October 14, 2005, Applicants filed an Amendment and Response on December 14, 2005. As indicated in the Advisory Action dated January 10, 2006, the foregoing Amendment and Response was entered however, according to the Examiner, the Response and Amendment did “not place the application in condition for allowance”. Accordingly, Applicants file herewith a Request for Continued Examination and the present Amendment and respectfully request that the present Amendment be entered.

Claims 1, 2, 4, 6, 8-12, 50, 51, 53-55, 57, 58, and 61-86 were pending in this application. Claims 67, 77-80, 84, and 86 have been amended and new claims 87-114 have been added. Accordingly, upon entry of this amendment, claims 1, 2, 4, 6, 8-12, 50, 51, 53-55, 57, 58, and 61-114 will be pending.

The Examiner indicated in the Advisory Action dated January 10, 2006, that the 35 U.S.C. §112, first and second paragraph rejections of record of the previously pending claims would be overcome by the Amendment and Response filed December 14, 2005. Accordingly, Applicants submit that the amended claims were in condition for allowance. Since the Restriction Requirement between isolated nucleic acid molecules encoding *human and murine* T-bet proteins, vectors, host cells and, methods of producing the protein issued in the January 24, 2005 Office Action was conditioned on the non-allowance of the linking claims, *i.e.*, claim 51, Applicants respectfully submit that the indication that all of the rejections against claim 51 have been overcome entitles Applicants to the examination of claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s). According to M.P.E.P. 809.04

[i]f a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the nonelected inventions that are linked to the elected invention by such allowed linking claim.

Accordingly, Applicants submit herewith new claims 87-114 directed to isolated nucleic acid molecules encoding murine T-bet proteins, vectors, host cells and, methods of producing the protein and respectfully request that these claims be examined.

Support for the amendments to the claims and the new claims may be found throughout the specification and claims, as originally filed. Specifically, support for new claims 87 and 88

can be found at, for example, page 15, lines 29-33 of the specification; support for new claims 89 and 90 can be found at, for example, page 8, lines 4-5, page 15, lines 10-14, and page 15, lines 20-28 of the specification; support for new claim 91 can be found at, for example, page 8, lines 28-35 of the specification; support for new claim 92 can be found at, for example, page 28, lines 19-22 of the specification; support for new claim 93 can be found at, for example, page 15, lines 10-14 of the specification; support for new claim 94 can be found at, for example, page 18, lines 10-25 of the specification; support for new claims 95, 96, 107, 108, 113, and 114 can be found at, for example, page 19, lines 28-34 of the specification; support for new claims 97 and 109 can be found at, for example, page 23, lines 12-13 of the specification; support for new claims 98, 99, 110, and 111 can be found at, for example, page 23, line 35, through page 24, lines 1-6 of the specification; support for new claim 100 can be found at, for example, page 7, lines 5-6 and lines 8-9, page 14, line 27, through page 15, lines 1-3, and page 39, lines 6-10, Examples 5-10, page 66, line 21, through page 71, lines 1-10 of the specification; support for new claims 101 and 112 can be found at, for example, 24, lines 10-14 of the specification; support for new claim 102 can be found at, for example, 37, lines 27-31 of the specification; support for new claims 103-105 can be found at, for example, 20, lines 22-24 of the specification; support for new claim 106 can be found at, for example, 40, lines 23-26 of the specification;

No new matter has been added. Any amendment and/or cancellation of the claims should in no way be construed as an acquiescence to any of the Examiner's rejections and was performed solely in the interest of expediting prosecution of the application. Applicants reserve the right to pursue the claims as originally filed in this or a separate application(s).

Sequence Disclosure

The Examiner states that the substitute CRF filed July 22, 2005 with Applicants' response fails to comply with the requirements of 37 C.F.R. §1.821 through C.F.R. §1.825, because the <220> Features and associated headings are missing from SEQ ID NOs:5-9.

Applicants respectfully submit herewith a Substitute Sequence Listing on paper and CRF with the <220> and associated headings as required by the requirements set forth in the Table

presented in C.F.R. §1.823. Accordingly, Applicants request reconsideration and withdrawal of the rejection under C.F.R. §1.821- C.F.R. §1.825.

Withdrawal of Certain Objections/Rejections

Applicants gratefully acknowledge the Examiner's indication that the following objections/rejections have been withdrawn:

the rejection of claims 50, 60, and 64 under 35 U.S.C. §112, second paragraph, as being indefinite for the recitation of the term ““initiation of Th1 cell differentiation of Thp cells and Th2 cells”;

the rejection of claim 60 under 35 U.S.C. §112, second paragraph, as being indefinite for the recitation of “prosthetic group”;

the rejection of claim 64 under 35 U.S.C. §112, second paragraph, as being indefinite and lacking antecedent basis in for the recitation of “wherein the Th1-associated cytokine is...IL-2”; and

the rejection of claim 60 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, new matter.

Rejection of Claim 50 Under 35 U.S.C. §112, First Paragraph

The Examiner has rejected claim 50 because, according to the Examiner, Applicants' amendment “to claim 50 raises the issues of New Matter and possibly issues under 35 U.S.C. §112, first paragraph.” “With regard to New Matter, Applicant has not identified specifically where the support for the amendments is in the specification or original claims.”

Applicants respectfully traverse the foregoing rejection of claim 50. Claim 50 is directed to a nucleic acid molecule, wherein the polypeptide has at least one activity selected from the group consisting of: inducing IFN- γ production in CD4⁺ cells, inducing Th1-associated cytokine production, inhibiting production of IL-2, and differentiating Thp cells and Th2 cells into Th1 cells.

With respect to the Examiner's indication that the amendment to claim 50 presented in the December 14, 2005 Amendment and Response raises the issue of New Matter, Applicants respectfully submit that support for the newly added limitation "***inhibiting production of IL-2***" presented in the foregoing amendment can be found, at least at, page 7, lines 5-6 and lines 8-9, page 14, lines 32-34 of the specification. In addition, Applicants respectfully submit that the Examiner acknowledged in the Office Action dated October 14, 2005 at page 4, that the specification "discloses at page 14, lines 33 - 34, that ***T-bet leads to repression of IL-2 production***". (Emphasis added).

As such, Applicants submit that the limitation "inhibiting production of IL-2" in claim 50 is supported by the specification. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 50 under 35 U.S.C. §112, first paragraph.

Rejection of Claims, Double Patenting

Applicants acknowledge the Examiner's indication that the provisional rejection of claims 1, 2, 4, 6, 8-12, 50, 51, 53-55, and 57-59 under the judicially created doctrine of obviousness-type double patenting is maintained.

Applicants respectfully submit that upon an indication of allowable subject matter in this or the related applications Applicants will consider filing a terminal disclaimer, if appropriate.

SUMMARY

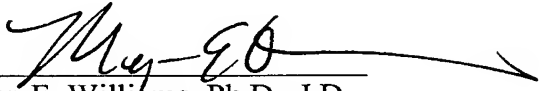
It is respectfully submitted that the Amendments and Comments presented herein place the application in condition for allowance.

Should the Examiner feel that a telephone conference with Applicant's Attorney would expedite prosecution of the application and allowance of the claims, the Examiner is urged to contact the undersigned representative at (617) 227-7400.

Applicants submit herewith the requisite fee associated with the filing of this Amendment. However, should any additional fee be due, please charge such fee to our Deposit Account No. 12-0080, under Order No. HUI-040CP, from which the undersigned is authorized to draw.

Dated: January 26, 2006

Respectfully submitted,

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